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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,225	12/08/2003	John DeNatale JR.		4628

7590

05/04/2004

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EXAMINER

NOVOSAD, JENNIFER ELEANORE

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/730,225

Applicant(s)

DENATALE, JOHN

Examiner

Jennifer E. Novosad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12-08-2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

This application, i.e., Application No. 10/730,225, repeats a substantial portion of prior Application No. 10/128,620, filed April 23, 2002, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it constitutes a "continuation-in-part" of the prior application. Application has improperly deemed this application a "continuation", while it is in fact a "continuation-in-part" application. *Thus*, this application filed under former 37 CFR 1.60 lacks the *correct* reference to the prior application. *Accordingly*, a statement reading "This is a continuation-in-part of Application No. 10/128,620, filed April 23, 2002, now abandoned." should be inserted for first sentence of the specification (page 2).

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because (a) the specification to which the oath or declaration is directed has not been adequately identified, and (b) the application number and filing date to which this application claims priority is not listed. See MPEP § 601.01(a).

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the panels and slots recited in claim 6 must be shown or the features canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "of a sufficient depth to allow portions... to extend beyond the periphery of the housing" in lines 8-9 and 15-16 of claim 1, renders the claim indefinite. *In particular*, a VCR tape is not an element of the claimed device and it is improper to seek to define claimed structure based on a comparison to some unclaimed element. *In this case*, the boundaries of the claim cannot be properly ascertained because one would not know whether their device infringed the instant claim until someone else later added a tape. *In other words*, a device as defined in the claims would infringe the claim with one particular tape while the exact same device would not

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infringe the claim when another tape is used. *Accordingly*, the features of the device, itself, must be defined instead of relying upon a comparison with an ascertained element.

The term "easily" in claim 3 (see line 3) is a relative term which renders the claim indefinite. The term "easily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The use of the phrase "may be" in claim 6 (see line 2) renders the claim indefinite since what "may be" to one "may not be" to another, and thus the metes and bounds of the claim cannot be properly ascertained, i.e., it is unclear what exactly is being set forth and claimed. *Further*, claim 6 appears to contradict the subject matter of claim 1 in that claim 1 requires that the first and second compartments be a specific size, i.e., 1 ¼ and ¾ inches, respectively, and then claim 6 seeks to require that the compartments may be of a desired size.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,031,779 (Szenay *et al.* '779) in view of U.S. Patent no. 5,685,423 (Hunt '423).

Szenay *et al.* '779 disclose a rotating display holder for media which comprises a generally housing (see Figure 1) with a flat bottom and a flat top (20) so that other holders can be

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stacked thereon (see Figure 4); the housing having first compartments on one side (right side of Figure 2) and second compartments on another side (left side of Figure 2). *With respect to claim 6*, in view of the Section 112 rejection (advanced above), the compartments are not customized, thereby meeting the limitation of the claim, i.e., note "may be".

The claims differ from Szenay *et al.* '779 in requiring: (a) the first compartments to have a width of approximately 1 ¼ inches to hold VCR tapes and the second compartments to have a width of approximately ¾ of an inch for holding DVD's (claim 1); (b) the holder to be made from wood (claim 4); and (c) the holder to be made from metal (claim 5).

*With respect to (a)*, Hunt '423 teaches that it is old to have a holder which comprises different sized compartments for storing and holding different sized media therein wherein some of the compartments are first compartments and the width thereof is 1 inch (see column 1, lines 44), i.e., 1 inch is considered to be *approximately* 1 ¼ inches, for holding video tapes case, i.e., VCR tapes; and some of the compartments are second compartments and the width thereof is 0.41 inches (see column 1, line 51), i.e., 0.41 inches is considered to be *approximately* ¾ inch, for holding video games and compact disc cases.

*Thus*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the holder of Szenay *et al.* '779 with different sized compartments for ease in use to the consumer since the holder can be used in different environments and for different uses.

*With respect to (b)*, Hunt '423 teaches the use of wood. *Accordingly*, it would have been an obvious design choice to one of ordinary skill in the art at the time the invention was made to

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have fabricated the holder from wood for ease in economy and manufacture while allowing for increased structural stability.

*With respect to (c)*, although Szenay *et al.* '779 do not disclose the use of metal, it would have been an obvious design choice to one of ordinary skill in the art at the time the invention was made to have fabricated the holder from metal for ease in economy and manufacture while allowing for increased structural stability.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szenay *et al.* '779 in view of Hunt '423 as applied to claims above, and further in view of U.S. Patent No. 6,464,088 (Caplan *et al.* '088).

The claims differ from the references advanced above in requiring the holder to be motorized (claim 2) and to be remotely controlled (claim 3).

Caplan *et al.* '088 teach that it is old to have a rotating holder for media which comprises the use of a motor and a remote control.

*Accordingly*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the holder of Szenay *et al.* '779 with a motor and remote control for increased ease in use to the consumer.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703)-305-2872. The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703)-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer E. Novosad  
Primary Examiner  
Art Unit 3634

Jennifer E. Novosad/jen  
April 29, 2004